

## REMARKS

The outstanding Office Action addresses claims 1, 3-15, and 37. Applicants appreciate the Examiner's indication that claims 7-15 represent allowable subject matter and that these claims would be allowed if rewritten in independent form. Applicants continue to submit, however, that independent claims 1 and 37 represent allowable subject matter, and reconsideration and allowance thereof is respectfully requested.

For the Examiner's convenience, Applicants attach hereto a clean version of the pending claims.

### *Rejections Pursuant to 35 U.S.C. §102(b)*

In the previous Office Action, the Examiner rejected claims 1, 3-6, and 37 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,201,739 of Semm in view of U.S. Patent No. 5,944,729 of Blake. The Examiner now rejects claims 1, 3-4, 6, and 37 pursuant to 35 U.S.C. §102(b) as being anticipated by Blake. Applicants disagree.

Claim 1 of the present invention recites a medical instrument for positioning an internal organ during a surgical procedure having a body with a tissue grasping element appended to the body and having first and second opposed tissue *penetrating* claws selectively movable between an open position and a closed position. Claim 37 recites a method that similarly requires a medical instrument having a tissue grasping element with opposed tissue *penetrating* claws.

The Examiner appears to have overlooked the requirement for tissue *penetrating* claws, arguing that

Blake discloses a medical instrument 10 which can be used as a gripping instrument having a body 34 with tissue *grasping* claws (26, 26) selectively movable between an open position and a closed position with the tissue *grasping* claws biased to a closed position, an actuating member with opposed members (22, 22) mated to the body and effective to move the claws between open and

closed positions and a flexible member or string 48 for placement, withdrawal or maneuvering of instrument 10 that is selectively fastenable to a support.

(Page 2, January 5, 2004 Office Action, *emphasis added.*)

Blake is limited to a radio-opaque vascular *clamp* having first and second jaws that are configured to clamp a vessel or tissue therebetween. Because the clamping surfaces are in facing relationship with one another, the jaws cannot *penetrate* tissue, as required by claims 1 and 37 of the present invention. In fact, Blake discloses the use of a foam layer on each clamping surface to reduce trauma to the clamped vessels. Accordingly, Blake does not teach or even suggest a medical instrument for positioning an organ that includes first and second opposed tissue penetrating claws.

Claims 1 and 37 are therefore not anticipated by Blake and represent allowable subject matter. Claims 3-6 are allowable at least because they depend from an allowable base claim.

***Rejections Pursuant to 35 U.S.C. §103(a)***

The Examiner further rejects claim 5 pursuant to 35 U.S.C. §103(a) as being obvious over Blake on the basis that “it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tissue grasping elements with a circular shape . . .” (Page 3, January 5, 2004 Office Action.) At the outset, Applicants note that claim 5 is allowable at least because it depends from allowable base claim 1. Claim 5 is also allowable for the following reasons.

As stated above, Blake is limited to a vascular *clamp*. If the clamp were modify to include opposed tissue penetrating jaws having a *circular* shape, such a configuration would cause the jaws to *penetrate* tissue, rather than clamp tissue. This is specifically contrary to the teachings or Blake, and such a modification of the Blake device would render the device ineffective for its intended use - - namely, to clamp tissue without causing trauma to the tissue. Accordingly, it would not have been obvious for a person having ordinary skill in the art to

modify the tissue grasping claws to have a circular shape, as taught and claimed by the present invention.

Applicants further note that the circular shape of the tissue penetrating claws of the present invention are particularly advantageous in that they facilitate the safe and effective penetration of tissue. The circular jaws will allow a sufficient amount of tissue to be engaged such that the risk of tearing is reduced, thereby allowing an organ or tissue engaged by the device to be manipulated and positioned.

Claim 5 therefore further distinguishes over Blake and represents allowable subject matter.

***Conclusion***

In view of the remarks above, Applicants submit that claims 1, 3-15, and 37 are in condition for allowance. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

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